

### **REMARKS**

Applicant thanks the Examiner for the careful attention given the application in the previous Office Action. Claims 22-24 of the present application are currently pending. In the Office Action mailed February 23, 2003, claims 22-24 have been rejected. For the reason set forth below, the Applicant respectfully traverses the rejections and submits that all pending claims are in condition for allowance and allowance of the application is respectfully requested.

#### **Double Patenting**

In the Final Office Action, the Examiner rejected claims 22-24 under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-13 of United States Patent No. 6,291,758.

In response, the Applicant has included herewith a terminal disclaimer in accordance with 37 CFR 1.321(c) to overcome the rejection based on nonstatutory double patenting. The Applicant respectfully requests allowance of the application.

#### **Rejections under 35 USC §103**

In the Final Office Action dated February 23, 2003, claims 22-24 were rejected under 35 U.S.C. §103(a) as being unpatentable United States Patent No. 5,834,999, issued to Kinman (hereinafter Kinman '999) or United States Patent No. 5,811,710, issued to Blucher et al. (hereinafter Blucher) in view of United States Patent No. 5,168,117, issued to Anderson (hereinafter Anderson). For the reasons set forth below, the Applicant respectfully traverses the rejections and respectfully submits that the pending claims define patentable subject matter over the cited prior art.

The Final Office Action states that Kinsman '999 and Blucher each disclose an upper coil and a lower coil, and a single non-magnetized ferromagnetic plate disposed between two coils. The Final Office Action further states that neither Kinsman '999 nor the Blucher discloses a completely flat ferromagnetic plate. In addition, the Final Office Action states Anderson discloses a pickup having a upper and lower coil having a completely flat flexible magnet plate disposed between two coils.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. (see MPEP  2143.03). The motivation to combine or modify a reference in order to make a rejection must be found within the prior art and not based on applicant's disclosure. The Applicant respectfully submits there is no teaching or suggestion in Kinsman '999 or Blucher directed to the use of a completely flat ferromagnetic plate positioned between the two coils. Further, the Applicant submits there is no teaching or suggestion in Anderson directed to the use of a ferromagnetic plate between the coils. Rather, Anderson which includes a flexible magnet between the two coils teaches away from Kinsman '999 and Blucher which both include a nonmagnetized ferromagnetic plate positioned between the coils. The Applicants respectfully submit that the Examiner has failed to show a motivation to combine the cited references to create the device recited in claims 22-24 and instead has relied on hindsight in rejecting the pending claims.

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 47 USPQ2d 1453 (Fed. Cir.1998) "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir.1999) The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Thus, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art

to deprecate the claimed invention." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In view of the foregoing, Applicant believes the pending claims to be in condition for allowance. Reconsideration and early allowance are respectfully and sincerely solicited.

If it is felt for any reason that direct communication with applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-1329.

Respectfully submitted,

Dated: 8/22/03

  
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